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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,449	04/17/2001	Hani Elgebaly	42390P11413	2387

8791 7590 12/01/2005

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,449

Applicant(s)

ELGEBALY ET AL.

Examiner

Aaron Strange

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 and 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Withdrawal of claims 11-20 and 25-30 is noted. Those claims have not been further considered herein. In the event that any of the claims are reinstated without amendment, the rejections presented in the Office action of 4/7/2005 will apply.

Response to Arguments

2. Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed 9/12/2005 have been fully considered but they are not persuasive.

4. With regard to claim 1, and Applicant's general assertion that Goldberg fails to teach the subject matter of claim 1 (Page 17, Lines 1-14 of Remarks), the Examiner respectfully disagrees. Applicant asserts "one endpoint (the third machine) sends a session initiation" (Page 17, Lines 4-5 of Remarks). However, the claim does not state that the third machine is an endpoint, only that it sends an initiation request. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, Applicant appears to assert that the use of a registration server differentiates Goldberg from the present claims (Page 17, Lines 8-11 of Remarks), but the argument is unclear. Applicant's invention also uses a registration server to register the endpoints (At least Page 8, Lines 7-13 of present application and claim 5), and the difference is not clear to the Examiner.

5. With regard to claims 2,4 and 21, and Applicant's general assertion that Goldberg fails to teach the claimed subject matter, the Examiner respectfully disagrees for at least the reasons outlined in the rejection of those claims below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-10 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The claims contain several errors with regard to antecedent basis and general clarity. The list below is provided to assist Applicant and should not be considered as comprehensive. Applicant's assistance in locating and fixing any other errors is appreciated.

9. With regard to claims 2-7, the preamble refers to "the protocol of claim 1", but the claims appear to refer to steps in a method, and claim 1 has been amended to recite "A method for". The Examiner recommends amending claims 2-7 to recite "the method of claim 1".

10. With regard to claim 6, the limitation "wherein the second machine is an endpoint to the communication session" is unclear. Based on Applicant's arguments, the session endpoints are the first machine and the third machine (Page 17, Lines 10-11 of Remarks). Appropriate amendment and/or explanation is required.

11. With regard to claim 7, the limitation "receiving the initiation for the session from the second machine" is unclear. Claim 1, from which claim 7 depends, states that the session initiation is received by the first machine from the third machine. It is unclear how it may also be received by the network translation device from the second machine.

12. Claim 8 recites the limitation "said modified protocol" in line 10. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 8 recites the limitation "the embedded network address" in line 12. There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 8 recites the limitation "the apparent origin address" in line 13. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 10 recites the limitation "the second network address" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 10 recites the limitation "the third machine" in lines 5 and 7. There is insufficient antecedent basis for this limitation in the claim.

17. With regard to claim 23, the rejection presented in the Office action of 4/7/2005 is MAINTAINED, since the claim has not been amended and no arguments were made to overcome the rejection.

18. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-3 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldberg et al. (WO 02/03217 A1).

21. With regard to claim 1, Goldberg discloses a method for establishing a communication session through a network translation device with a communication protocol utilizing a single communication port for setting up the communication session and transferring data the communication session, the method comprising:

preparing a session setup for a session with a first machine, the session setup identifying an internal origin address (internal IP address) and a first internal port to which the first machine (Client B) expects a response to the session setup (Page 6, Lines 21-23);

sending the session setup to a second machine (application server) through the network translation device, the second machine configured to recognize if the session setup includes the internal origin address, and if so to associate with the first machine the routable external origin address of the network translation device (Page 6, Line 19 to Page 7, Line 9);

receiving by the first machine (Client B) a communication session initiation request from a third machine (Client A), said initiation having an associated external address/port for the third machine (Page 20, Lines 2-5);

sending an acknowledgement to said initiation to the external address/port so as to prime the network translation device to receive the session from the third machine (Page 20, Lines 6-13).

22. With regard to claim 2, Goldberg further discloses sending content for the communication session from the first machine to the third machine, wherein the third machine is configured to wait for content from the first machine before the third machine sends content to the first machine (Page 20, Lines 28-30).

23. With regard to claim 3, Goldberg further discloses receiving data for the session from the third machine responsive to said priming (Page 20, Lines 15-18).

24. With regard to claim 4, Goldberg further discloses that the protocol comprises modification to an original communication protocol (SIP) requiring utilizing different communication ports for setting up the communication session and transferring data during the communication session (Page 19, Lines 21-32).

25. With regard to claim 21, Goldberg discloses a method for a first endpoint internal to a network translation device to set up a communication session with a second endpoint external to the network translation device, the method comprising:
contacting a registration server to resolve an alias for the second endpoint (INVITE/SDP is sent to app server);

receiving a first session registration from the registration server (INFO/NAT message is received from app server), the first session registration comprising a network address for the second endpoint that is routable, and a content port to which content should be sent to for the second endpoint (Page 20, Lines 13-15);

and priming the network translation device, by sending at least one network packet to the second endpoint at the routable address on the content port, before completing setting up the communication session with the second endpoint (Send RTP/NAT message) (Page 20, Lines 2-30 and Fig 12);

receiving content for the communication session on the content port (Page 20, Lines 28-29).

26. With regard to claim 22, Goldberg further discloses sending a second session registration for the first endpoint to the registration server, the second session registration comprising a network address for the first endpoint that is non-routable (Page 19, Lines 18-20).

27. With regard to claim 23, as best understood by the Examiner, Goldberg further discloses that the registration server receives session registrations from both the first and second endpoints. The server first determines which endpoints are located behind a NAT (Page 19, Lines 12-20). While Goldberg fails to specifically disclose that the devices are registered, this limitation is inherent, because the server provides the

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appropriate addressing information to each endpoint when assisting with the connection setup (Page 20, Lines 2-30).

28. With regard to claim 24, Goldberg further discloses that the registration server is configured to identify the non-routable network address within the second session registration, and responsive to said identifying, registering the first endpoint with respect to a routable address associated with the network translation device (Page 19, Lines 14-20).

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 5, 8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (WO 02/03217 A1) in view of Fallentine et al. (US 2002/0042832).

31. With regard to claim 5, while the system disclosed by Goldberg shows substantial features of the claimed invention (discussed above), it fails to disclose that the session setup includes an alias and a registration server receiving the session setup

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and registering the first machine with respect to the alias and its' external origin address.

Fallentine teaches a method of registering endpoints of a communication session which reside behind a NAT using the IP address and alias of the endpoint. This would have been an advantageous addition to the system disclosed by Goldberg since it allows unique aliases to be used to identify each endpoint for session1 identification (¶48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to register endpoints with respect to their external origin addresses and aliases, in order to provide unique identifiers for session identification.

32. With regard to claim 8, Goldberg discloses a method for a registration server to facilitate communicating between a first endpoint (Client A) behind a network address translator (NAT) and a second endpoint (application server), comprising: receiving a first registration for the first endpoint according to a protocol utilizing a single communication port for both setting up a communication session and transferring data during the communication session, said registration comprising an embedded address (IP address) and embedded port primed by the first endpoint (Page 6, Lines 21-23), wherein said priming by the first endpoint includes sending data from the first endpoint using the embedded port to prime the NAT to receive responsive data in accord with said modified protocol (Page 20, Lines 2-30); determining the embedded network address is a non-routable address (Different from the external address) (Page 7, Lines

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4-9). However, Goldberg fails to specifically disclose that the session setup includes an alias and a registering the first endpoint with respect to the alias, port, and apparent origin address.

Fallentine teaches a method of registering endpoints of a communication session which reside behind a NAT using the IP address and alias of the endpoint. This would have been an advantageous addition to the system disclosed by Goldberg since it allows unique aliases to be used to identify each endpoint for session1 identification (¶48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to register endpoints with respect to their external origin addresses and aliases, in order to provide unique identifiers for session identification.

33. With regard to claim 9, Goldberg further discloses receiving from the second endpoint a resolution request for the alias (INFO/NAT message) (Page 20, Lines 20-21); replying to said request with at least the apparent origin address (reINVITE message); receiving an initiation for the session from the second endpoint (response w/SDP); and forwarding the session setup to the first endpoint at the apparent origin address (Page 20, Lines 20-30).

Allowable Subject Matter

34. While some of the claims remain somewhat unclear, as best understood by the Examiner, the subject matter of claims 6, 7 and 10 appears that it would be allowable if

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rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
11/28/2005



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PRIMARY EXAMINER